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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/091,508	10/30/1998	JAMES T. CONNORS	68567/PALL	5023 32

7590 10/02/2003

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EXAMINER

MENON, KRISHNAN S

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 10/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 32

Application Number: 09/091,508
Filing Date: October 30, 1998
Appellant(s): CONNORS ET AL.

Shannon Schemel
For Appellant

EXAMINER'S ANSWER

MAILED
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GROUP 1700

This is in response to the appeal brief filed 7/18/03.

(1) *Real Party in Interest*

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A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1 and 14-19 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

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5,543,047	Stoyell et al	8-1996
4,228,012	Pall et al	10-1980
4,517,085	Driscoll et al	5-1985
4,033,881	Pall et al	7-1977

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 and 14-19 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 29.

(11) Response to Argument

Appellant's main arguments are that the primary reference Pall (923) is a completely different and teaches away from the claimed invention of two or more hollow pack sections being coaxially joined by open joiner, and that the references in combination do not teach the 'at least 40 inch length and at least 2 inch interior diameter'.

1. Argument that "the claims are directed to a separation element including two or more pack sections and adjacent open joiner caps ... an arrangement that allows fluid to flow through the connected pack sections" whereas, "Pall (923) is directed to filter units having a reserve filter element in series with the primary filter element, the reserve filter element not coming in to use until the primary filter element ... becomes plugged": Claim 1 is open ended (comprising). Pall (923) teaches two filters coupled together with open joiner caps to coaxially connect them. Appellant's argument re the second filter of the '923 patent being a reserve filter is not germane to the claim because the relief valve interposed between the filters is an added feature. See figures 1-3, col 2 lines 5-10 and col 4 lines 5-69. The 'reserve filter feature' is brought about by

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the relief valve-assembly, which is in the annular space outside the coupling between the filters.

Re Pall (923) teaching away from connecting the pack sections and open joiner caps into a hollow separation arrangement “that allows the fluids to flow through all the pack sections”, the claim does not recite “... allows the fluids to flow through all the pack sections” , and Pall (923) filter assembly does allow the filtrate flow to go through all the filter elements all the time, and the fluid to be filtered to go through all the elements when the relief valve opens. Also, please note that the “Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments” (In re *Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971)).

2. Re argument that the secondary references fail to remedy the deficiencies of Pall (923) in terms of the coaxial connections with open joiner caps: Even though the secondary references were not used for this purpose, Pall (012) teaches linking two or more modular units end-to-end in coaxial connection to increase the filter capacity (col 1 lines 15-33).

3. Argument re the ‘at least 40 inch length’ and ‘at least 2 inch’ diameter of the hollow separation arrangement: These are result-effective variables which would be determined based on the space availability for filter installation and the filter capacity required. Discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art. In re Boesch and Slaney, 205 USPQ 215 (CCPA 1980); In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); In re Aller, 42 CCPA 824, 220 F.2d 454, 105 USPQ 233 (1955). Pall (012) teaches coupling modular units end-to-end to extend filter capacity (col 1 lines 15-33). Also, In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only

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difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. In this instant case, the filter assembly as taught by Pall (923) in view of Stoyell and Pall (012) would not perform differently from what is claimed in claim 1. Also, Pall (012) teaches 'any number of modular units' which means 'to any length' including 40 inches.

4. Argument re increasing length without increasing diameter, again, claim 1 does not positively recite a structural connection between the length and diameter for the 'packs'. Re argument that the claimed combination of length and interior diameter provides much higher throughput, the higher throughput is an obvious result of providing a larger filter, which is what the examiner was trying to explain in the quoted paragraph from the final rejection.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,


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September 30, 2003


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